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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/653,193

09/03/2003

Masami Mackawa

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11/12/2009

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EXAMINER

PORTER, RACHEL L

ART UNIT

PAPER NUMBER

3626

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DELIVERY MODE

11/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/653,193

Applicant(s)

MAEKAWA, MASAMI

Examiner

RACHEL L. PORTER

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/29/09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Appeal Brief filed 7/27/09. Claims 1-21 are pending.

2. In view of the appeal brief filed on 7/27/09, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/C. Luke Gilligan/

Supervisory Patent Examiner, Art Unit 3626

Election/Restrictions

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3. Newly submitted claim 21 was directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Since applicant received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits.

Accordingly, claim 21 was withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

4. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement in the response filed 3/26/09, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 1 recites the limitation "the examination set" in line 8. There is insufficient antecedent basis for this limitation in the claim. The claim does not previously recite an examination set.

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8. Further regarding claim 1, it is unclear to the Examiner which class of invention the applicant intends to claim. In particular, it is not clear whether the applicant is attempting to claim the examination scheduling program (software) **or** a system (i.e. the nuclear medical examination apparatus, computer memory storing computer executable instructions, computer/processor to perform...)

As the examiner understands the invention, applicant is attempting to claim the examination scheduling program (software). However, software programs must be embodied on computer readable medium. It is not clear from the current claim language whether the recited examination scheduling program (i.e. software program) is stored on a computer readable medium. The phrase "having computer executable instructions stored in computer memory for causing a computer to create a schedule for each patient including an examination by the nuclear medical examination apparatus and a medication accompanying the examination" apparently describes the nuclear medical examination apparatus, and does not refer back to the recited examination scheduling program.

Claims 2-20 inherit the deficiencies of claim 1 through dependency, and are therefore also rejected.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 currently recites “[a]n examination scheduling program for a single nuclear medical examination apparatus having computer executable instructions stored in computer memory for causing a computer to create a schedule for each patient including an examination by the nuclear medical examination apparatus and a medication accompanying the examination, said program causing said computer to perform” in the preamble. The claim then recites a series of functions.

As it is currently recited, it is not clear that the examination scheduling program (software *per se*) is embodied on computer readable storage medium. (see the rejection under 112, 2nd paragraph).

It should be noted that data structures not embodied on a computer readable media are considered descriptive material. They are therefore considered non-statutory because they are not capable of causing a functional change in a computer. As drafted, the claim fails to define any structural and functional interrelationships between the code and other elements of a computer that permit the computer program’s function to be realized. (See MPEP § 2106.01)

Claims 2-20 contain similar deficiencies and fail to correct the deficiencies of claim 1, and are therefore also rejected.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kameda et al (US 5,923,018--hereinafter Kameda) in view of White et al (US 2004/0019501 A1)

[claim 1] Kameda discloses an examination scheduling program, said program causing said computer to perform:

- function for fetching information on contents of the examination for each patient and an order of examination for each patient; and (col. 10, lines 40-60; col. 17, lines 54-col. 18, line 31)
- a function for fetching a waiting time from the medication to the examination set according to a type of examination; (Figure 2; col. 10, lines 1-49; Figure 7; col. 17, lines 54-col. 18, line 31—time increments between medication and testing/process are displayed)
- a function for generating (i.e. displaying) an examination schedule of patients (Figures 4-5; col. 4, lines 45-56)

Kameda discloses the program as described above, but does not expressly disclose a function for creating an examination schedule based upon contents of the examination for each patient and an order of examination for each patient, and waiting time.

White discloses a system and application for generating/creating an examination schedule and patient queues and tracking based upon retrieved patient data, patient order, and waiting time required for given procedures (Figs. 2B, 7B, 8B, 9A-B; par. 38-41, 44-45, 49, 54-55). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to combine the system of Kameda of with the teaching of White to create an examination schedule based on information on contents of the examination, an order of examination and the waiting time. As suggested by White, one would have been motivated to include this feature to permit the staff members to define the steps in the medical testing process, to track the flow of patients from step to step in the medical testing process, to record the completion of steps as to individual patients, and to organize priorities for staff members carrying out each step. (par. 29)

Also, it should be noted that the recitation of "to avoid overlapping in time between timing of the medication and examination for each patient" is intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

[claim 2] Kameda discloses an examination scheduling program as defined in claim 1, wherein said schedule for each patient is expressed by a pattern having a time span according to the type of examination, said pattern presenting the timing of the medication, the waiting time and the contents of the examination. (Figure 8; col. 18, lines 9-31)

[claim 3] Kameda discloses the examination scheduling program as defined in claim 1, wherein said schedule for each patient is displayed in form of a pattern on a time chart, with a line representing present time displayed to move on the time chart with progress of time. (Figures 5-7)

[claim 4] Kameda discloses the examination scheduling program as defined in claim 2, wherein said schedule for each patient is displayed in form of a pattern on a time chart, with a line representing present time displayed to move on the time chart with progress of time. (Figures 4, 9)

[claim 5] Kameda discloses the examination scheduling program as defined in claim 1, wherein said schedule is altered by moving said pattern on said time chart with a pointing device.

[claims 6-8] Kameda discloses the examination scheduling program as defined in claim 2, wherein said schedule is altered by moving said pattern on said time chart with a pointing device. (col. 12, lines 56-59—various input devices include a mouse, i.e. a point device)

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[claims 9-16] Kameda discloses an examination scheduling program, wherein said schedule for each patient is under control, and a correlation is made between actual measurements including actual medication and examination times, and data collected by said medical examination apparatus. (Figure 5, 6, 9; col. 17, lines 1-48; col. 18, lines 32-66)

[claims 17-20] Kameda discloses the examination scheduling program as defined in 1, further comprising a step of inputting an actual medication time, a step of comparing a scheduled medication time and said actual medication time, and a step of creating an examination schedule all over again when said step of comparing shows a disagreement. (Figure 5; col. 17, lines 1-29: result flag shows if medical action has or has not been performed.)

Response to Arguments

12. Applicant's arguments filed 7/26/09 have been fully considered but they are not persuasive.

(A) Applicant argues that Kameda does not meet the claim limitations because an operator performs the recited functions in the Kameda reference.

In response, the Examiner respectfully disagrees with applicant's interpretation of the Kameda reference. The system and method of Kameda is computer-implemented, and applicant has claimed a computer program for retrieving data, and scheduling. To the extent that an operator may be perform some steps in Kameda, the data retrieval

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and scheduling are performed using a computer, and therefore require a computer program.

As best understood by the Examiner, the applicant currently claims an application/software program. However, the current claim language describing functions of the software program do not preclude the description of a graphical user interface or an operator performing the functions at a computer using the software program (i.e. retrieving/fetching waiting time using the GUI, radio buttons or pull-down menu provided by a software application and using this information to create the schedule)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHEL L. PORTER whose telephone number is (571)272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, (Christopher) Luke Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L. P./
Examiner, Art Unit 3626

/C. Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626